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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,405	01/09/2002	Kia Silverbrook	WSM010US	2054

24011 7590 12/08/2003

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

SONG, SARAH U

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/040,405	Applicant(s) SILVERBROOK, KIA	
	Examiner Sarah Song	Art Unit 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's communication filed on September 16, 2003 has been carefully considered and placed of record in the file. Claims 1 and 12 have been amended. Claims 13-19 have been added. Claims 1-19 are pending.

Election/Restrictions

2. Newly submitted claims 13-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions I (claims 13-19) and II (claims 1-12) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process such as one wherein the caps can be formed by etching.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (Group I in class 264/239 and Group II in class 385/88), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Han et al.

(previously relied upon).). Han et al. discloses an optical fiber terminator package including:

a. A semiconductor chip 16 having a top surface and a bottom surface and including at least one first and second optical device 14 which emits or receives electromagnetic radiation at one or more wavelengths from the top surface;

b. A first hollow cap (15, 20 and 22) having a central portion (recess shown in Figure 2a) and four perimeter walls extending from a perimeter edge of the central portion with a free edge of each perimeter wall bonded to the top surface to provide a first cavity which, in plan view, overlays at least part or all of at least one light emitting device, said central portion including:

i. At least one region (the central opening shown in Figure 2a or optical element 20) which is at least substantially transparent or translucent to electromagnetic radiation at said one or more wavelengths; and

The cap further includes first and second attachment means 24, 26 (one on each side of the central portion. Han et al. also discloses a second cap 18 bonded to the bottom surface of the chip 16, said second cap, in plan view, overlaying at least part or all of at least one first optical

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device. Regarding claim 11 and 12, see Figure 4a, which shows first and second regions that refract electromagnetic radiation passing therethrough. Note also claims 1-7, 9 and 10 of Han et al. It is additionally noted that the method limitation of “wherein the first cap has been bonded to the semiconductor chip at the wafer stage prior to separation of the wafer into individual packages” is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Response to Arguments

5. Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive. Applicant states that Han et al. does not disclose or suggest bonding of the cap to the semiconductor chip at the wafer stage. As stated in the rejection above, the method of making the device is not germane to the issue of patentability of the device itself. In particular, the method limitation of “wherein the first cap has been bonded to the semiconductor chip at the wafer stage prior to separation of the wafer into individual packages” does not structurally distinguish the claimed invention from the device of Han et al. Therefore, Han et al. anticipates the device as set forth in the claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Steinberg et al. (U.S. Patent Application Publication) discloses optical package assembly at a wafer level as being within the level of ordinary skill in the art. See paragraph [0033].

7. Any inquiry concerning the merits of this communication should be directed to Examiner Sarah Song at telephone number 703-306-5799. Any inquiry of a general or clerical nature, or

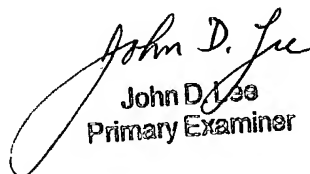
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relating to the status of this application or proceeding should be directed to the receptionist at telephone number 703-308-0956 or to the technical support staff supervisor at telephone number 703-308-3072.


SUS


John D. Lee
Primary Examiner